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In re application of	:	
Bruno Colin et al.	:	DECISION ON
Serial No. 09/936,077	:	PETITION
Filed: December 3, 2001	:	

For: APPARATUS ENABLING LIQUID TRANSFER BY CAPILLARY ACTION THEREIN

This is a decision on the PETITION UNDER 37 CFR 1.181 TO WITHDRAW THE FINALITY OF THE OFFICE ACTION, MAILED May 17, 2005.

On December 1, 2004, a non-final office action was mailed to applicants. The office action contained a rejection under 35 USC 102 (b) over Nilsson et al.

A reply to the office action was filed on February 28, 2005. In the reply, applicants amended independent claim 9. The amendment overcame the 35 USC 102(b) rejection.

On May 17, 2005 a final office action was mailed. The previous rejection was withdrawn and a new ground of rejection was added. All of the claims were now rejected under 35 USC 102(e) over newly cited art to Kellogg. The examiner stated in the office action that the new ground of rejection was necessitated by Applicant's amendments to the claims and the office action was made final. On June 2, 2005, the instant petition was timely filed.

Petitioner has argued that the finality of the last office action is improper. Petitioner argues that the new ground of rejection was not necessitated by Applicant's amendment.

DECISION

Section 706.07(a) of the MPEP states:

706.07(a) Final Rejection, When Proper on Second Action

Under present practice, second or any subsequent actions on the merits shall be final, except where the examiner introduces a new ground of rejection that is neither necessitated by applicant's amendment of the claims nor based on information submitted in an information disclosure statement filed during the period set forth in 37 CFR 1.97(c) with the fee set forth in 37 CFR 1.17(p).

The non-final office action contained a proper rejection under 35 USC 102(b) over all of the pending claims in view of Nilsson et al. Applicants amended the independent claim to add the limitation that each shallow groove is adjacent to the deep grove along the entire length of said deep grove. This limitation overcame the Nilsson et al. reference. It is argued that because applicants overcame the previous rejection and were unaware of the newly cited reference, it would not be proper to make the present action final. It is also argued that because the independent claim was narrowed by the previous amendment, the new ground of rejection was not necessitated by amendment because the newly cited reference was also applicable to the previous broader version of the claim.

This argument is not persuasive. In the instant case, when applicants amended the claim to overcome the prior art, a new ground of rejection was required. The new rejection was required due to applicant's amendment to the claim. The fact that the newly cited reference was also applicable against the broader, previous version of the claim, does not change the fact that applicant's amendment clearly caused it to be cited. Under petitioner's scenario, if a newly cited rejection could not be made final if it was applicable against a previously presented broad claim, then one would be given unlimited attempts to overcome references by amendment until an allowable claim was presented. The only solution would be for the examiner to made multiple, cumulative rejections covering every possible amendment that applicant could make. This contradicts the present final rejection practice and compact prosecution. In the instant case, the examiner had no way of knowing that applicants would choose to amend the claims in the manner they did so as to necessitate a new reference containing the newly presented limitation. As a final point, it is noted that the previous ground of rejection was made under 35 USC 102(b) whereas the new rejection was made under 35 USC 102(e). Generally speaking, a 102(b) rejection is a stronger rejection than a 102(e) so therefore, the examiner made the strongest rejection available in the non-final office action.

Petitioner also urges that the newly cited reference was not cited by applicants and was first cited in the final office action. This has no bearing on whether the new ground of rejection was necessitated by applicant's amendment.

Accordingly, the examiner properly made the May 17, 2005 office action final. The petition is **DENIED**

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